

REMARKS

This Response is submitted in response to the final Office action mailed on May 4, 2005. Claims 1-28 are pending in this application. In the Office Action, Claims 1-23 and 25-28 are rejected under 35 U.S.C. §103. In view of the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1-17, 23 and 25-28 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,669,975 to Abene ("Abene"). Applicants respectfully disagree with and traverse this rejection for at least the reasons set forth below.

Independent Claims 1, 4, 8 and 11-13 recite, in part, obtaining an individual pet profile for the pet, wherein the individual pet profile includes information based on user input and information obtained from a biological sample analysis of the pet. As an example, the biological sample analysis can determine a pet's individual reaction to a diet and the pet's ability to change its health status. Contrary to the present claims, *Abene* fails to disclose an individual pet profile that includes information based on user input and information obtained from a biological sample analysis of the pet. The Patent Office admits same. See, Office Action, page 4.

Applicants respectfully disagree with the Patent Office's inherency argument alleging that providing an individual pet profile that includes information based on user input and information obtained from a biological sample analysis of the pet is inherent to any skilled veterinarian. See, Office Action, page 4. The only discussion of information used for a pet profile within *Abene* arises with respect to a profile form completed by a person. In fact, *Abene* fails to disclose or even suggest any type of biological analysis anywhere in the specification. Moreover, the Patent Office has not provided any support or teaching within *Abene* regarding same.

To satisfy the test for inherency, providing an individual pet profile that includes information would necessarily (i.e. always or automatically) have to follow from information obtained from a biological sample analysis of the pet according to the present claims. That condition simply is not met under the present circumstances. For example, providing an individual pet profile could be based on information from the pet owner's personal knowledge or preferences and not necessarily from any biological sample analysis of the pet. Further, veterinarians can perform physical and observational tests on a pet and are not required to do any

kind of biological analysis to provide information about the pet profile. Indeed, there are a number of alternative information resources for providing an individual pet profile other than from a biological sample analysis of the pet according to Applicants' present claims as required for inherency.

Applicants also respectfully disagree with the Patent Office's assertion that the claimed methods would have been obvious as the methods are no more than what a trained veterinarian would be capable of doing if a pet owner would bring a pet to the vet's office. See, Office Action, page 4. Applicants respectfully submit that "obvious to try" is not the proper standard under 35 U.S.C. §103. The fact that the claimed invention is within the capabilities of one having ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. See, MPEP 2143.01. Instead, the Patent Office is improperly using a subjective standard to base its obviousness rejection without providing any objective reasons or support.

For the reasons discussed above, Applicants respectfully submit that Claims 1, 4, 8 and 11-13 and Claims 2-3, 5-7, 9-10, 14-17, 23 and 25-28 that depend from these claims are novel, nonobvious and distinguishable from the cited reference. Therefore, Applicants respectfully request that the rejection of Claims 1-17, 23 and 25-28 under 35 U.S.C. §103 be withdrawn.

Claims 18-23 have been rejected under 35 U.S.C. §103 as being unpatentable over *Abene* in view of U.S. Patent No. 6,042,857 to Jones et al. ("Jones"). Applicants respectfully submit that the patentability of Claim 13 renders moot the obviousness rejections of Claims 18-23. In this regard, the cited art fails to teach or suggest the elements of Claims 18-23 in combination with the novel elements of Claim 13.

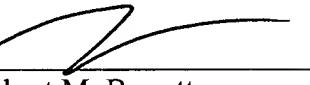
Applicants note for the record that Claim 24 has not been rejected. Thus, Applicants request that the record reflect that this claim is allowed.

In the Office Action dated October 11, 2005, the Patent Office requires a properly executed Terminal Disclaimer over U.S. Patent No. 6,493,641. Claims 8-28 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-81 of U.S. Patent No. 6,493,641. Submitted with this response is a Terminal Disclaimer disclaiming the terminal part of any patent granted on the pending application extending beyond the expiration date of the following U.S. Patent No. 6,493,641.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

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